

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY E. ELLIOTT

Appeal 2007-1909
Application 10/608,290
Technology Center 3600

Decided: September 7, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-3 and 11-40.¹ We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is to an adjustable tool for facilitating the positioning of a repair clamp on a pipe for sealing a leak (Specification 1:2-5).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. Apparatus for installing a repair clamp on a pipe, said repair clamp including a generally cylindrical body having first and second opposed edge flanges, a slot extending the length thereof for receiving the pipe and positioning said repair clamp about an outer circumference of the pipe, and plural nut and bolt combinations coupled to said edge flanges for drawing the repair clamp tightly about the pipe, said apparatus comprising:

a body portion having first and second opposed ends;

¹ The Final Office Action of December 23, 2005 rejected claims 1-40 under 35 U.S.C. § 103(a) as being unpatentable over Bosco and Murray. The Examiner subsequently withdrew this rejection as it pertains to claims 4-10 (Answer 3). As such, there are no outstanding rejections of claims 4-10.

an arm having a first end pivotally coupled to said body portion adjacent the first end thereof, said arm further including a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp;

a clasp pivotally coupled to said body portion intermediate the first and second opposed ends thereof and adapted to engage an outer edge of the repair clamp's second edge flange when said body portion is in a first position relative to said arm and clasp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of said body portion about said arm and clasp to a second position draws the repair clamp's edge flanges together for securely maintaining the repair clamp on and in engagement with the pipe and allowing the nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner, wherein said arm and said clasp may be disengaged and removed from the edge flanges and the apparatus removed from the repair clamp following tightening of the nut and bolt combinations; and

adjustable means disposed in said body portion for coupling said clasp to said body portion and adjusting spacing between said arm and said clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Murray	US 1,619,749	Mar. 1, 1927
Bosco	US 1,445,286	Feb. 13, 1923

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ISSUE

The Examiner determined that the claimed apparatus would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the teachings Bosco and Murray (Answer 3-4). In particular, the Examiner found that Bosco discloses an apparatus having an arm including “a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp” as recited in independent claims 1 and 21 (Answer 3). The Appellant contends that the distal ends of claws 14 and 15 of Bosco are not adapted to be inserted in an aperture in the first edge flange of the repair clamp (Appeal Br. 13). The issue before us is whether the Appellants have shown that the Examiner erred in finding that Bosco discloses an apparatus having an arm including a second opposed end adapted for insertion in an aperture in a repair clamp.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Bosco discloses a form clamp particularly designed for holding together the separable parts of a concrete mold and a separate tool which is used to draw together interlocking members of the clamp (Bosco, p. 1, ll. 8-10 and 51-53).
2. Bosco's clamp comprises a single flexible band having adjustably secured thereto a pair of members 4, 5 formed for interlocking engagement for securing the band around the form (Bosco, p. 1, ll. 47-51).
3. Bosco's interlocking members 4, 5 each include a pair of transversely-disposed slots 7 for receiving the ends of the band and apertures 11 arranged to receive a locking pin 12 (Bosco, p. 1, ll. 74-77 and 96-98).
4. Bosco's interlocking members each include a pair of oppositely disposed lugs or flanges 8, 10, which are engaged by the tool 6 for drawing the members 4, 5 into position for interlocking (Bosco, p. 1, ll. 92-96).
5. Bosco's tool 6 comprises a lever arm 13 having oppositely disposed claws 14 and 15 pivotally mounted on pins 16 and 17, respectively, so that the claws are drawn inwardly toward each other by the movement of the lever arm (Bosco, p. 1, ll. 104 – p. 2, l. 1).
6. Bosco's claws 14 and 15 are adapted to engage the lugs 8 and 10 on the clamp and are not disclosed as being adapted for insertion in an aperture in a first edge flange of a repair clamp (Bosco, Figs. 2 and 3).

7. Murray discloses a clamp for use with concrete molds for clamping and retaining mold parts or sections of a mold in fixed and spaced relation (Murray, p. 1, ll. 1-5).
8. Murray's clamp is formed of two jaw parts 5, 6, with jaw part 5 comprised of a crosshead 7 and a shank 8 (Murray, p. 1, ll. 49-56).
9. Murray discloses a link lever 19 pivoted to the end of jaw part 6 and attached by means of a wing nut 21 to a lever 15 (Murray, p. 1, ll. 102-109).
10. Murray describes that in operation, when the lever 15 is moved downwardly, this forces the link lever 19 laterally and downwardly, thus causing the face of jaw 6 to swing inwardly into engagement with a wall 25 of a concrete mold or form (Murray, p. 2, ll. 32-37).
11. Murray's apparatus does not include an arm adapted for insertion in an aperture in a first edge flange of a repair clamp.

PRINCIPLES OF LAW

"It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (citations omitted). Although "[a] patent applicant is free to recite features of an apparatus either structurally or functionally ... choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk." *Id.* at 1478, 44 USPQ2d at 1432. As the court stated in *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971):

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possess the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Where, however, the functional limitation in a claim expressly or impliedly requires a particular structure different from that in the prior art, the claimed subject matter is distinguishable from the prior art. *Compare In re Casey*, 370 F.2d 576, 580-81, 152 USPQ 235, 239 (CCPA 1967) (holding that a claim to “[a] taping machine comprising ... a brush ... being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere” is obvious over a prior art reference which taught a machine for perforating sheets, because “the references in [the claim] to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of [the prior art].”)

ANALYSIS

Independent claims 1 and 21 recite an apparatus comprising “an arm having ... a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp.” This recitation is a structural limitation of the claims that requires one end of the tool’s arm to be structurally configured so as to allow the end to fit in an aperture in a repair clamp edge. Both Bosco and Murray disclose clamps particularly designed for use with a concrete mold (Findings of

Fact 1 and 7). Bosco further discloses a separate tool which is used to draw together interlocking members of the clamp (Finding of Fact 1). Bosco's tool comprises a lever arm having oppositely disposed claws pivotally mounted, so that the claws are drawn inwardly toward each other by the movement of the lever arm (Finding of Fact 5). Bosco's claws are adapted to engage lugs on the clamp and are not disclosed as being adapted for insertion in an aperture in a first edge flange of a repair clamp (Finding of Fact 6). Murray's clamp, in operation, uses a lever to force a link lever laterally and downwardly, thus causing the face of the clamp's jaw to swing inwardly and engage a wall of a concrete mold (Finding of Fact 10). As such, Murray's clamp does not include an arm adapted for insertion in an aperture in a first edge flange of a repair clamp (Finding of Fact 11).

The Examiner has not provided any evidence showing a prior art pipe repair clamp having an aperture in a first edge flange, so as to provide any basis for his finding that Bosco's claw is adapted for insertion into such an aperture. Where the functional limitation in a claim expressly or impliedly requires a particular structure different from that in the prior art, the claimed subject matter is distinguishable from the prior art. Since there is no evidence on the record before us of the size or shape of a prior art aperture in a pipe repair clamp flange, the Examiner has failed to make a prima facie showing that Bosco's claws are adapted for insertion in an aperture in the first edge flange of the repair clamp, as recited in claims 1 and 21, and thus he has failed to set forth a prima facie showing of obviousness of claims 1 and 21 and claims 2-20 and 22-40, which depend therefrom.

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CONCLUSIONS OF LAW

The Appellants have shown that the Examiner erred in rejecting claims 1-3 and 11-40 under 35 U.S.C. § 103(a) as unpatentable over Bosco and Murray.

DECISION

The decision of the Examiner to reject claims 1-3 and 11-40 is reversed.

REVERSED

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